

### REMARKS

Applicants appreciate the Final Office Action of July 30, 2003. Applicants have amended Claims 1, 11 and 21 to reflect the addition of an "and" between the last two recitations of these claims. Applicants respectfully submit that Claims 31, 33 and 35 are in compliance with 37 C.F.R. § 1.75(c). Applicants further submit that dependent Claims 32, 34 and 36 are patentable over the cited references. Furthermore, pending Claims 1-36 stand rejected for the same reasons as in the Office Action of February 12, 2003. Applicants submit that all the claims are patentable over the cited references for at least the reasons discussed in Applicants' previous amendment, which is incorporated herein by reference as if set forth in its entirety. To expedite reconsideration of this application, only the new points in the Final Office Action will be addressed below. Applicants respectfully submit that this case is in condition for allowance.

#### **Response to Claim Objections**

Claims 31, 33 and 35 stand objected to under 37 C.F.R. § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. The Final Office Action states:

The limitation of claim 31 states, 'customizing the requested document identified by the link element based on the inserted at least on [sic] of said plurality of requested client properties,' which is found in its parent claim of claim 1 which states, 'inserting at least one of said plurality of requested client properties into a request so as to allow customization of the requested document identified by the link element based on the inserted at least one of said plurality of requested client properties.'

See Final Office Action, page 2. Applicants respectfully disagree that Claims 31, 33 and 35 are in improper dependent form. Claims 1, 11 and 22 recite "inserting at least one of said plurality of requested client properties into the request so as to allow customization of the requested document." In other words, the at least one of plurality of requested client properties is inserted into the request and may be used to customize the requested document. Nothing in Claims 1, 11 and 22 specifically recites actually "customizing the requested document" as recited in Claims 31, 33 and 35. Accordingly, Applicants submit that Claims 31, 33 and 35 are in proper dependent form and request that the rejections with respect to these claims be withdrawn.

**Rejection of New Claims 32, 34 and 36**

Claims 32, 34 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 5,948,061 to Merriman *et al.* (hereinafter "Merriman") in view of United States Patent No. 6,401,085 to Gershman *et al.* (hereinafter "Gershman").

Applicants respectfully submit that the recitations of these Claims are neither disclosed nor suggested by the cited combination. For example, Claim 32 recites "wherein at least one of the plurality of requested client properties is associated with hardware characteristics of the client." Claims 34 and 36 contain similar recitations.

The Final Office Action admits that Merriman "does not specifically teach at least one of the plurality of requested client properties is associated with hardware characteristics of the client." *See* Final Office Action, page 6, paragraph 19. However, the Final Office Action points to Gershman as providing the missing teachings. There is no motivation or suggestion to combine the cited references as suggested in the Final Office Action. As recently affirmed by the Court of Appeals for the Federal Circuit in *In re Sang-su Lee*, a factual question of motivation is material to patentability, **and cannot be resolved on subjective belief and unknown authority**. *See In re Sang-su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983).

The Final Office Action states:

It would have been obvious to one skilled in the art at the time the invention was made to combine Gershman with Merriman because having hardware as at least one requested client property could aid in the transmission, storage and compatibility of the system that is transmitting the client information.

*See* Final Office Action, page 6, paragraph 19. This motivation is a motivation based on "subjective belief and unknown authority", the type of motivation that was rejected by the Federal Circuit in *In re Sang-su Lee*. The Final Office Action must point to a specific portion of the cited references that would induce one of skill in the art to combine the cited references as suggested in the Final Office Action. If the motivation provided in the Final Office Action is considered an adequate motivation, anything that "could aid in the transmission, storage and compatibility of the system" would be considered obvious. This cannot be the case.

Accordingly, the statement in the Final Office Action with respect to motivation does not adequately address the issue of motivation to combine as discussed in *In re Sang-su Lee*. Thus, it appears that the Final Office Action gains its impetus or suggestion to combine the cited references by hindsight reasoning informed by Applicants' disclosure, which, as noted above, is an inappropriate basis for combining references.

For at least the foregoing reasons, Applicants respectfully submit that dependent claims 32, 34 and 36 discussed above are independently patentable over the cited references. Accordingly, Applicants submit that dependent Claims 32, 34 and 36 are in condition for allowance, which is respectfully requested in due course.

**The Response to Arguments:**

In the Response to Arguments section of the Final Office Action, the Examiner asserts a new section of Merriman. In particular, the Final Office Action cites column 5, line 33 to column 7, line 43 of Merriman as teaching the recitations of Claims 1, 11 and 22. *See* Final Office Action, page 10, paragraph 36. The Final Office Action states:

As is very apparent, the first two sections of claim 1 is a common way for users to select a web site through a hyperlink. The third part of claim 1 can be found in Merriman, where in the reference Merriman teaches "The preferred embodiment also includes determining which advertising object should be selected if two or more advertising objects have criteria matching the user selection from the matched advertisements by determining how often the particular user has been exposed to the given advertisement," as for one example. In this passage the server where the advertisements are held save information from the user as the user selects the advertisement hyperlink, and in doing determines the type of advertisement the user will receive from the accumulated information the advertisement server has on the user.

*See* Final Office Action, page 11, paragraph 38. Applicants respectfully disagree.

Merriman discusses a method of tailoring advertisements placed on or around requested documents/information on a display based on information provided by the user and/or a user's web activities. The cited portion of Merriman relates to the advertising server processes 19 illustrated in Figure 1 of Merriman. The cited portion states, in part:

If the user is an existing user, **the ad server 19 obtains from a database all of the information known about the user** including the user's geographic location, the domain type (commercial educational, governmental, the Internet service provided), the organization type where the user works (for example a SIC code), the company size, the number of employees in that company, the particular types of

advertisements that the user has clicked on by SIC or other appropriate coding and the number of times that the user has been exposed to each advertisement currently in the system as described in FIG. 3A. Also, the relative time of day for the user is calculated based upon either the user's country code or the user's IP access provider or the location of their domain. . . .

The preferred embodiment also includes determining which advertising object should be selected if two or more advertising object have criteria matching the user. selecting from the matched advertisements by determining how often the particular user has been exposed to the given advertisement. **For each user, data is kept about the number of times that a user has seen a given advertisement based upon the user ID.** For each advertisement where the user matches the criteria, if the number of times that the user has seen the advertisement is less than a predetermined threshold, the advertisement is retained as one of the possible matches. If the number of times that the user has seen a given advertisement exceeds the threshold, the advertisement is discarded as a possible candidate for transmitting back to the user.

See column 5, line 50 to column 6, line 26 (emphasis added). In other words, the ad server obtains as much information as possible about the user and uses the obtained information to tailor the advertisement to the user. Furthermore, if two advertisements appear to be particularly appropriate for the user based on the obtained information, Merriman discusses a process of choosing between the two advertisements based on the number of times a particular advertisement has been presented to the user.

In contrast, Claims 1, 11 and 22 recite receiving a link element associated with a server, the link element **including a plurality of requested client properties** and inserting at least one of said plurality of requested client properties into the request **so as to allow customization of the requested document** identified by the link element based on the inserted at least one of said plurality of requested client properties. In other words, according to embodiments of the present invention, the server receives the information it requests, not a dump of all "the information known about the user." Accordingly, the rejections with respect to Independent Claims 1, 11 and 22 and the claims that depend therefrom should be withdrawn as the cited references fail to disclose or suggest many of the recitations of these claims.

In the Response to Arguments at paragraphs 39 through 48, the Final Office Action attempts to respond to Applicants' arguments with respect to many of the dependent claims. The Final Office Action states:

There are no remarks that specifically state why, reasons or lack of functionality in the references that were used to reject ... (the argued dependent claims), to support

specifically why the stated references do not disclose the limitations stated in ... (the argued dependent claims).

See Final Office Action, pages 11-14, paragraphs 39-48. In their previous Amendment, Applicants specifically stated why the recitations of the independent claims were not taught or suggested by the cited references. The dependent claims argued as separately patentable in Applicants' previous Amendment discuss details with respect to these recitations of the independent claims. Accordingly, Applicants respectfully submit that many of the dependent claims are independently patentable over the cited references for these reasons and the reasons specifically set out in Applicants' previous Amendment.

With regard to the Examiner's comments on the motivation for combining references, Applicants agree that "any judgment of obviousness is in a sense necessarily a reconstruction based on hindsight reasoning," (See Final Office Action, page 16, paragraph 52) however, according to the Federal Circuit, "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art **also suggests the desirability of the combination**." See M.P.E.P. § 2143.01(citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). The Federal Circuit further stated:

This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion....

*In re Sang Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). In other words, the Final Office Action must point to a specific portion of the cited references that would induce one of skill in the art to combine the cited references as suggested in the Final Office Action and cannot base the motivation on subjective belief and unknown authority. Accordingly, the statements in the Final Office Action with respect to motivation do not adequately address the issue of motivation to combine as discussed in *In re Sang-su Lee*. Accordingly, the rejections should also be withdrawn for at least these additional reasons.

### CONCLUSION

Applicants respectfully submit that, for the reasons discussed above and those in the Applicants' previous Amendment, the references cited in the present rejections do not disclose or suggest the present invention as claimed. Accordingly, Applicants respectfully submit that the above-entitled application is now in condition for allowance. Favorable reconsideration of this application, as amended, is respectfully requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (919) 854-1400.

It is not believed that an extension of time and/or additional fee(s)-including fees for net addition of claims-are required, beyond those that may otherwise be provided for in documents accompanying this paper. In the event, however, that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned under 37 C.F.R. §1.136(a). Any additional fees believed to be due in connection with this paper may be charged to our Deposit Account No. 50-0220.

Respectfully submitted,

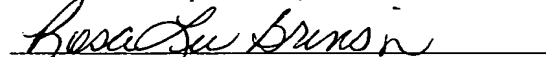


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